

## REMARKS

1. In response to the Office Action mailed October 26, 2009, Applicant respectfully requests reconsideration. Claims 1-33 and 58 were last presented for examination. In the outstanding Office Action, claims 1-33 and 58 were rejected. No claims have been amended, added or cancelled. Upon entry of this paper, claims 1-33 and 58 will remain pending in this application. Of these thirty-four (34) claims, 3 claims (claims 1, 16 and 58) are independent.

2. Based upon the above Amendment and following Remarks, Applicant respectfully requests that all outstanding objections and rejections be reconsidered, and that they be withdrawn.

### ***Claim Rejections under §103 – Jeutter in view of Kung***

3. Claims 1-4, 11, 12, 16-19, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,314,453 to Jeutter in view of U.S. Patent No. 6,366,817 to Kung. Applicant respectfully requests reconsideration for at least the following reasons.

#### ***The proposed combination of Jeutter and Kung does not contain all elements of Applicant's claims***

4. Independent claim 1 recites, in part, “measuring the strength of a magnetic field proximal to the external transceiver, wherein the magnetic field is generated at least in part by the external transceiver....” (See, Applicant’s claim 1, above.) Applicant respectfully submits that none of the cited references teach or render obvious this limitation of claim 1.

5. In order to establish a *prima facie* case of obviousness, it is well established that “the Examiner must show that each and every limitation of the claim is described or suggested by the prior art or would have been obvious based on the knowledge of those of ordinary skill in the art.” (See *e.g.*, *Ex Parte Hans-Wilm*, 2009 WL 4695166, \*2 (Bd.Pat.App. & Interf. December 4, 2009), citing, *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988)).

6. In the outstanding Office Action, it appears that the Examiner recognizes that none of the cited references teach the above-noted limitation. (See, Office Action, pg. 2-3.) Instead the

Examiner appears to argue that combination of references renders the above-noted limitation of claim 1 obvious. (*Id.*) Applicant respectfully disagrees.

7. As previously noted by Applicant, Jeutter is directed to a medical device that is implanted behind a tissue barrier within a person's body. (*See*, Jeutter, col. 2, lns. 33-36.) Jeutter discloses that the internal receiver includes a magnet affixed to it. (*See*, Jeutter, Fig. 2, ferrous magnet 27; col. 3, lns. 15-20.) The external transmitter comprises a magnetically operated reed switch that senses the presence of the internal magnet to determine whether the external transceiver should transmit power to the internal receiver. (*See*, Jeutter, col. 4, lns. 63 - col. 5 ln. 5.) As such, Jeutter merely discloses detecting the presence of an internal magnet.

8. Kung is directed to an electromagnetic field source for providing electromagnetic energy to a secondary coil implanted in a recipient. (*See*, Kung, Abstract.) In an embodiment of Kung, a plurality of primary coils 110A and 110B are embedded in a mattress. (*See*, Kung, col. 7, lns. 41-42, FIG. 1 and 2.) The recipient may then lay on the mattress and electromagnetic energy is transmitted from the primary coils to the secondary coil implanted in the recipient. (*See*, Kung, col. 3 lns. 3-10.). Kung further discloses a proximity detector 126 that determines the approximate distance between the primary coils and the secondary coil, and adjusts the amount of current to the primary coils to optimize transmissions for the current distance. (*See*, Kung, col. 3 lns.13-16, FIG. 1.)

9. Kung discloses that the distance between a primary coil and a secondary coil is measured by determining the resonant frequency of the primary coil. (*See*, Kung, col. 19 lns. 14-39.) Particularly, Kung discloses that the resonant frequency of the primary coil is first determined when the coil is not in the presence of the secondary coil. (*See*, Kung, col. 19 lns. 16-18.) Then, the resonant frequency is determined when the primary coil is in the presence of the secondary coil. (*See*, Kung, col. 19 lns. 21-25.) The difference in frequencies, referred to as the frequency shift, can thus be determined. Using principals of mutual inductance, this frequency shift can then be used to determine the distance between the primary and secondary coils. (*See*, Kung, col. 19, lns. 25-49.)

10. In the outstanding Office Action, the Examiner relies on Jeutter for disclosing "measuring the strength of a magnetic field proximal to the external transceiver and determining a position

of the external transceiver relative to the implanted transceiver from the measured magnetic field.” (See, Office Action, pg. 2.) The Examiner then relies on Kung for disclosing “an external transceiver that can generate a magnetic that can be used by an implanted device to determine the relative position.” (See, Office Action, pg. 2.) The Examiner then alleges that these teachings could be combined to meet the above-noted limitation of Applicant’s independent claim 1. In support, the Examiner offers the following statement:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the generated magnetic field as taught by Jeutter with a magnetic field generated at least in part by the external device as taught by Kung since such a modification would provide the predictable results of allowing a physician or technician to easily access the magnetic field generator and thus more easily perform maintenance on the generator. (See, Office Action, pg. 6.)

11. However, as previously explained by Applicant, the externally generated magnetic field of Kung could not be used in the system of Jeutter without rendering Jeutter unsuitable for its intended purpose. Moreover, contrary to the Examiner’s assertions, the alleged “predictable results” of allowing more easy access to the magnetic field generator and performance of maintenance would not be predictable at all, as such the Examiner’s proposed substitution would render the system of Jeutter inoperable.

12. In the outstanding Office Action, the Examiner did not contest Applicant’s argument in the prior response that the proposed combination would render Jeutter unsatisfactory for its intended use. (Office Action, pgs. 2-3.) Rather, the Examiner cited *In re Keller* which holds that the test for obviousness is “what the combined teachings of the references would have suggested to those of ordinary skill in the art.” (Office Action, pg. 3 citing *In re Keller*, 642 F.2d 413, 425 (CCPA 1981)). This case, however, is not in conflict with the *In re Gordon* decision that Applicant’s cited in Applicant’s prior response. Rather, *In re Gordon* helps explain when the combined teachings of the references would NOT have suggested to those of ordinary skill to combine the references.

13. As recently explained by the Board of Patent Appeals and Interferences (BPAI), “if the proposed combination would render the prior art invention being modified unsatisfactory for its

intended purpose, *then there is no suggestion or motivation to make the proposed combination.*” (*Ex Parte Donovan*, 2009 WL 4702439, \*4 (BPAI December 3, 2009), citing *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984), *emphasis added*.) Thus, *In Re Gordon* explains a situation where the test proposed in *In re Keller* is not satisfied and the proposed combination is, therefore, not obvious.

14. As previously explained by Applicant and not contested by the Examiner, substituting the externally generated magnetic field of Kung for the internal magnet of Jeutter, as proposed by the Examiner, would render Jeutter unsatisfactory for its intended purposes. (*See*, Applicants’ Response of September 28, 2009; Office Action pgs 2-3.) Thus, because the proposed combination would render Jeutter unsatisfactory for its intended purpose, there is no suggestion or motivation to combine Jeutter and Kung as proposed by the Examiner. Thus, Applicant respectfully submits that the proposed combination of Jeutter and Kung fails the test proposed in *In re Keller*. Applicant therefore respectfully requests that the Examiner reconsider and withdraw the rejection to claim 1 for at least this reason.

15. Independent claim 16 recites, in part, “[a]n apparatus ... comprising: means, for measuring the strength of a magnetic field proximal to the external transceiver, wherein the magnetic field is generated at least in part by the external transceiver.” Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of independent claim 16 for at least similar reasons to those discussed above.

16. As a secondary matter, Applicant note that the Examiner identified col. 15 lines 50-56 as the relied on portion of the Kung specification. (*See*, Office Action, pg. 4.) This portion of Kung refers to the orientation of the coils in an embodiment of Kung. (*See*, Kung, col. 15 lns. 50-56.) Applicant believes the Examiner meant to refer to col. 19 of Kung, which refers to the noted proximity detector of Kung, rather than col. 15 of Kung.

#### ***Claim Rejections under §103 – Chen in view of Kung***

17. Claims 1-7, 11-22 and 28-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen in view of Kung. Claims 8-10, 23-27, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen in view of Kung as applied to claim 1 above, and further in view

of U.S. Patent Application Publication No. 2003/0074035 to Bornhoft et al. (hereinafter, "Bornhoft"). Applicant respectfully requests that the rejection be reconsidered and withdrawn for at least the following reasons.

18. In the Office Action, the Examiner relied on the identical basis for combining Chen and Kung as the Examiner relied on for allegedly supporting a combination of Jeutter and Kung. As with the combination of Jeutter and Kung, combining Kung with Chen would render Chen unsatisfactory for its intended purpose.

19. As noted above, Chen discloses being able to detect the presence of an internal receiver by sensing the presence of magnets implanted along with the internal receiver. If these internal magnets were replaced with an externally generated magnetic source, then the system of Chen would be unable to detect the presence of the internal receiver. Instead, the system of Chen would simply detect the externally generated magnetic source, which if collocated with the external transceiver as suggested by the Examiner, would always be detected by the detection mechanism of Chen. Thus, if the internal magnets of Chen were replaced with an externally generated magnetic source, the system of Chen would be unable to locate the implanted receiver and thus would be rendered unsatisfactory for its intended purpose.

20. Applicant therefore respectfully requests that the rejection of independent claims 1 and 16 be reconsidered and withdrawn for at least the additional reason that the proposed combination would render Chen unsuitable for intended purpose, and, thus there is no suggestion or motivation to make the proposed combination.

***Claim Rejections of Claim 58 under §102 or §103***

21. Claim 58 is rejected under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 6,138,681 to Chen et al. (hereinafter, "Chen"), or in the alternative under 35 U.S.C. §103(a) as obvious over Chen.

22. Independent claim 58, as amended, recites "means for indicating that the external transceiver has been displaced when the measured strength of the magnetic field proximal to the external transceiver is greater than the threshold value." (See, Applicant's amended claim 58, above).

23. In the Office Action, the Examiner appears to recognize that Chen does not disclose “means for indicating that the external transceiver has been displaced when the measured strength of the magnetic field proximal to the external transceiver is greater than the threshold value,” as recited by independent claim 58. Instead, the Examiner argues (1) that the phrase is merely functional, and (2) that “Applicant has not disclosed that requiring the measured strength to be greater than the threshold value provides an advantage, is used for a particular purpose, or solves a stated problem.” (*See*, Office Action, pgs. 4-5.)

24. With regard to the language allegedly being functional, Applicant respectfully disagrees. The cited limitation recites a particular means that is configured in such a manner to indicate “that the external transceiver has been displaced when the measured strength of the magnetic field proximal to the external transceiver is greater than the threshold value.” This language is not merely functional, but specifies a particular manner in which the means for indicating is structured. Moreover, Chen is not configured to operate in such a manner.

25. In Chen, the magnetic field is generated by internal magnets. As such, when the internal and external units are separated, the magnetic field sensed by the external unit will drop. As such, Chen could only detect that the internal and external units are separated if the magnetic field fell below a threshold and not if it exceeded a threshold. Particularly, in order, for a measured distance to be above a particular distance, the measured magnetic field in the system of Chen must drop below a particular value corresponding to such distance. Thus, the system of Chen could not determine that the internal unit and external unit are displaced by determining that the measured strength of the magnetic field proximal to the external transceiver is greater than a threshold value. Rather, in Chen the magnetic field would drop as the two units became separated.

26. As such, Chen is not configured in such a manner that Chen could detect “that the external transceiver has been displaced when the measured strength of the magnetic field proximal to the external transceiver is greater than the threshold value.” As such, Chen does not anticipate “means for indicating that the external transceiver has been displaced when the measured strength of the magnetic field proximal to the external transceiver is greater than the threshold value,” as recited in Applicant’s claim 58.

27. As noted above, the Examiner also rejected claim 58 because “Applicant has not disclosed that requiring the measured strength to be greater than the threshold value *provides an advantage, is used for a particular purpose, or solves a stated problem.*” (See, Office Action, pgs. 4-5, *emphasis added.*) In reviewing the MPEP for the legal basis for this rejection, it appears that the Examiner is relying on MPEP §2144.04 (Aesthetic Design Changes) and asserting that this limitation of Applicant’s claim 58 is simply a cosmetic design choice.

28. In describing *In re Sied*, 161 F.2d 229, MPEP §2144.04 states that “[t]he court found that matters relating to ornamentation only which have *no mechanical function* cannot be relied upon to patentably distinguish the claimed invention from the prior art.” (See, MPEP §2144.04 citing *In re Sied*, 161 F.2d 229 (CCPA 1947); *emphasis added.*) The recited configuration of Applicant’s amended claim 58, however, has a mechanical function, provides an advantage and is used for a particular purpose. For example, determining when the measured strength is greater than a threshold value is used for the particular purpose of determining when the external transceiver has been displaced. Secondly, this provides, for example, the advantage of being able to indicate to the user that the external transceiver is displaced so that they may correct the alignment.

29. Applicant therefore asserts that the determining “when the measured strength of the magnetic field proximal to the external transceiver is greater than the threshold value,” is used for a particular purpose and has an advantage. As such, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of independent claim 58 for at least this additional reason.

### ***Dependent claims***

30. The dependent claims incorporate all the subject matter of their respective independent claims and add additional subject matter which makes them independently patentable over the art of record. Accordingly, Applicant respectfully asserts that the dependent claims are also allowable over the art of record.

***Conclusion***

31. In view of the foregoing, this application should be in condition for allowance. A notice to this effect is respectfully requested.

32. Applicant reserves the right to pursue any cancelled claims or other subject matter disclosed in this application in a continuation or divisional application. Any cancellations and amendments of above claims, therefore, are not to be construed as an admission regarding the patentability of any claims and Applicant reserves the right to pursue such claims in a continuation or divisional application.

Dated: January 26, 2009

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